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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,396	03/13/2001	Michael S. Cohen	10004164-1	1699

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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Fort Collins, CO 80527-2400

EXAMINER

JACOBS, LASHONDA T

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,396

Applicant(s)

COHEN, MICHAEL S.

Examiner

LaShonda T Jacobs

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-11 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-11 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is in response to Applicant's amendment filed on November 12, 2004.

Claims 1-2, 5-11 and 14-18 are presented for further examination.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-2, 5-11 and 14-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Onaga in view of Lahmi.

As per claims **1** and **10**, Onaga discloses a method of allocating use of peripheral devices in a network system comprised of:

- providing peripheral devices access limitations to the users by the central device (abstract, col. 3, lines 46-67, col. 4, lines 1-4, and col. 10, lines 1-42);
- informing the peripheral devices of the access allowed to users by the central devices (col. 10, lines 1-42); and
- permitting a user to communicate with the central device, via the internet, by inputting information into one of the peripheral devices such that status information pertaining to the one of the peripheral devices is provided to the user (abstract, col. 3, lines 46-67, col. 4, lines 1-4, col. 5, lines 2-10 and col. 10, lines 1-42).

Art Unit: 2157

However, Onaga does not explicitly disclose:

- identifying users in the network to a central device;
- wherein peripheral devices perform document processing;
- reading marks on documents to be processed by the one of the peripheral devices; and
- identifying, by the marks, the documents to the central device.

Lahmi discloses a method and device for securely duplicating, sensitive documents including:

- identifying users in the network to a central device (col. 5, lines 54-58, col. 6, lines 59-67, col. 7, lines 1-3 and col. 15, lines 48-66);
- wherein peripheral devices perform document processing (abstract, col. 5, lines 59-67, col. 6, lines 1-2, col. 12, lines 51-63 and col. 15, lines 15-31);
- reading marks on documents processed by the peripheral devices (col. 9, lines 66-67, col. 10, lines 1-10, lines 42-50 and col. 13, lines 19-34); and
- identifying, by the marks, the documents to the central device, such that processing of the documents by the one of the peripheral devices is permitted if access of the user corresponds to the documents (col. 9, lines 66-67, col. 10, lines 1-10, lines 42-50 and col. 15, lines 37-66).

Given the teaching of Lahmi, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Onaga by allowing the peripherals devices to read marks on documents in order to identify sensitive documents and users on a network in order to provide a secure method for processing/duplicating sensitive documents.

As per claims 2 and 11, Onaga discloses:

Art Unit: 2157

- accounting peripheral device usage of the users by the central device (col. 1, lines 32-47, , col. 4, lines 46-65, col. 5, lines 2-10 and col. 10, lines 1-16).

As per claims 5 and 14, Onaga discloses:

- relating the identified documents to users that request the identified documents (col. 10, lines 31-35, col. 12, lines 51-67 and col. 13, lines 1-9).

As per claims 6 and 15, Onaga discloses:

- providing an embedded virtual machine in each of the peripheral devices wherein the embedded virtual machine interfaces to the central device (col. 4, lines 46-62).

As per claims 7 and 16, Onaga discloses:

- wherein at least one of the peripheral devices is a multi-functional peripheral device whereby the central device configures the multi-functional peripheral device to serve specific functions (col. 2, lines 26, lines 33, col. 4, lines 62-65 col. 6, lines 35-42, col. 10, lines 60-67 and col. 11, lines 1-5).

As per claims 8 and 17, Onaga discloses:

- wherein the central device comprises of logic in a server connected to the network system (col. 4, lines 46-62).

As per claims 9 and 18, Onaga discloses:

- providing the users with collective and individual information and status of the peripheral devices (col. 10, lines 31-35, col. 12, lines 51-67 and col. 13, lines 1-9).

Response to Arguments

3. Applicant's arguments filed November 12, 2004 have been fully considered but they are not persuasive.

The Office notes the following arguments:

a. Applicant respectfully asserts that the recited combination is legally deficient for the purpose of rendering obvious claims 1 and 10 because at least features/limitations permitting a user to communicate with the central device, via the internet, by inputting information into one of the peripheral devices such that status information pertaining to the one of the peripheral devices is provided to the user and such that processing of the documents by the one of the peripheral devices is permitted if access of the user corresponds to the documents are not taught or reasonable suggested by the combination.

In response to:

a. Onaga and Lahmi disclose substantially the invention as broadly claimed. In addition, the applicant asserted that neither Onaga nor Lahmi disclose the limitations of claims 1 and 10 underlined above. The examiner disagrees with the precedent assertion. The examiner kindly submits that the applicants misread the applied references. However, Applicants are interpreting the claims very narrow without considering the broad teaching of the reference stated in the rejection. The aforementioned assertion permitting a user to communicate with the central device, via the internet, by inputting information into one of the peripheral devices such that status information pertaining to the one of the peripheral devices is provided to the user and such that processing of the documents by the one of the peripheral devices is permitted if access of the user corresponds to the documents are not disclose by Onaga and Lahmi with regard to the

Art Unit: 2157

invention of claims 1 and 10 was supported by objective factual evidence and was not found to be of substantial evidentiary value. The examiner has provided in the last office action of the parent application, a convincing line of reasoning as to why the artisan would have found the claim invention to have been obvious in light of the teachings of the cited references. Onaga discloses a data processing system for printing jobs originating from workstations on a computer network using an intelligent peripheral device. The status information regarding about the intelligent device are communicated from the file server to the user (abstract, col. 3, lines 46-67, col. 4, lines 1-4, col. 5, lines 2-10 and col. 10, lines 1-42). On the other hand, Lahmi discloses a method and device for securely duplicating sensitive documents by allowing users with authorization to print the documents (col. 9, lines 66-67, col. 10, lines 1-10, lines 42-50 and col. 15, lines 37-66). Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater 162 USPQ 541, 550-51 (CCPA 1969).

Applicants asserted that combining Onaga with Lahmi does not describe permitting a user to communicate with the central device, via the internet, by inputting information into one of the peripheral devices such that status information pertaining to the one of the peripheral devices is provided to the user and such that processing of the documents by the one of the peripheral devices is permitted if access of the user corresponds to the documents. In response, the examiner disagrees with the preceding allegations. However, Applicants are interpreting the

Art Unit: 2157

claim very narrow without considering the broad teaching of the references used in the rejection.

Applicants are reminded that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art.

Furthermore, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya USPQ 607 (CCPA 1975). On the other hand, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. As per Applicants' arguments that all claim limitations be taught or suggested by the prior art, Applicants appear to misinterpret the guidance given under MPEP 2142. In particular, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

There are numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions In re Delisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davies 208 USPQ 871; and In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1596, 1598 (Fed. Cir. 1988) (Citing In re Lalu, 747 F.2d 703, 705,

Art Unit: 2157

223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined In re Lamberti et al., 192 USPQ 278 (CCPA) that:

- (a) obviousness does not require absolute predictability;
- (b) non-preferred embodiments of prior art must also be considered; and
- (c) the question is not express teaching of references, but what they would suggest.

(B). According to In re Jacoby, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In re Bode, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement, that which is disclosed therein.

Furthermore, the skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the examiner for the reasons and motivations given above as well as in the prior office action. Thus the combined teachings of Onaga and Lahmi when considered as a whole to one of ordinary skill in the art make obvious that Applicants dispute. Hence the 35 U.S.C 103 is hereby sustained.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 2157

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

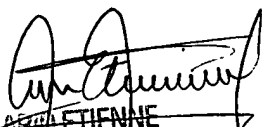
Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T. Jacobs whose telephone number is 703-305-7494. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShonda T. Jacobs
Examiner
Art Unit 2157

ltj
March 1, 2005


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